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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,002	03/15/2001	Robert Stanley Arling	10010131-1	4587

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EXAMINER

BLECK, CAROLYN M

ART UNIT PAPER NUMBER

3626

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/808,002

Applicant(s)

ARLING ET AL.

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 21 August 2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the application filed 15 March 2001. Claims 1-20 are pending. The IDS statement filed 21 August 2003 has been entered and considered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. Presently, claim 8 recites an apparatus yet there appear to be no apparatus elements within the claim. Claim 1 recites a report yet there appear to be no apparatus elements to generate the report within the claim. The omitted elements include a means for generating the report (i.e., a computer, processor, or report generator) and/or a source for the data that is retrieved and inserted into the field (i.e., a database).

Claims 2-7 and 9-14 incorporate the deficiencies of claims 1 and 8, respectfully through dependency, and are therefore rejected as well.

### ***Claim Rejections - 35 USC § 101***

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4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes on invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

(A) Claims 1-3 appear to be directed toward an electronically generated medical report. However, it is unclear as to which recognized statutory class of invention the database report of claim 1 is directed. In particular, a report is not a process or method as it lacks a series of steps. A report is not a machine or system as there is no specific recitation of machine or system components. A report is not recognized as a composition of matter. A report, per se, is merely a collection of data.

Under the guidance of recent case law, the requirements of 35 U.S.C. 101 are met when "the practical application of the abstract idea produces a useful, concrete, and tangible result" (State Street Bank & Trust Co. vs. Signature Financial Group, Inc., 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)). However, the claims, as presently recited, do not appear to have a tangible result. Data structures or computer programs, in general, that are not claimed as embodied in

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computer-readable media are descriptive material per se, and are not statutory because they are not capable of causing functional change in a computer.

In particular, it is unclear whether the report, as recited in claims 1-7, is embodied on a specific readable medium within the technological arts (and thus tangible), since it appears the database table is not limited to any particular structural element. Such claimed data does not define any structural and functional interrelationships between the data and other claimed elements of an apparatus, which permit the purpose of the data to be realized (see MPEP section 2106 section IV, B, 1, (a) for further guidance). Simply stated, how is the claimed report tangibly embodied within a system and how is that embodiment structurally related to a system?

In light of the above, it is respectfully submitted that the claimed invention, although useful and concrete, is not tangible, and thus fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

(B) Claims 2-7 fail to also disclose any structural element that would produce a concrete and tangible result, and thus also fail to pass muster under 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4, 6-11, 13-18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Stoodley (6,611,846).

(A) As per claim 1, Stoodley discloses a report downloaded to a computer (col. 15 lines 4-16) comprising:

(a) a diagnosis list of stored diagnoses to be selected by a user on a computer (see Fig. 2A and 2D, col. 10 lines 11-30);

(b) fields in the report displaying test results for a given patient, wherein the results are listed in a table, wherein the results are retrieved and inserted into the table or fields of the table from the central server (Fig. 2A, 2D, 8, col. 10 line 66 to col. 11 line 6, col. 15 lines 4-16, col. 15 lines 29-67, col. 17 lines 5-15).

It is respectfully submitted that inserting the results into the table with fields is considered to be a form of "the measurement replacing the field."

(B) As per claim 2, Stoodley discloses a list of a plurality of defined values associated with one or more measurements (see Fig. 2d and col. 10 line 66 to col. 11 line 6).

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(C) As per claim 3, Stoodley discloses 1) by entering the patient's date of birth, the age of the patient is automatically calculated and entered in the age field, 2) calculating the total number of particular patient data and displaying the total number, and/or 3) graphing a plot of velocities of blood flow rate (cm/sec) within the selected vessels over a course of dates (see Fig. 2d, col. 10 lines 1-10, col. 10 line 66 to col. 11 line 31, col. 17 lines 35-52).

(D) As per claim 4, Stoodley discloses the measurement being a data and a duration.

(E) As per claim 6, Stoodley discloses in a related diagnosis field, the use may select from a list of diagnoses previously entered for the patient in the diagnoses screen (Fig. 2B (see 80), col. 10 lines 30-50).

(E) As per claim 7, Stoodley discloses the categories including clinical presentation, pathology, anatomy, treatment, and outcome (col. 4 lines 18-39).

(F) Claims 8-11, 13-14, 15-18, and 20 repeat the same limitations as claim 1-4 and 6-7, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

***Claim Rejections - 35 USC § 103***

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoodley (6,611,846) as applied to claims 1, 8, and 15, and further in view of Wood et al. (5,851,186).

(A) As per claims 5, 12, and 19, Stoodley fails to expressly disclose the report updating the measurement at the time the report is generated and every time the report is viewed.

Wood discloses a system wherein by clicking on the update button, the HTTP server and CGI programs of the ultrasound system update the remotely displayed image with the ultrasound image produced most recently by the ultrasound system (col. 11 line 29 to col. 12 line 11).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Wood within the system of Stoodley with the motivation of allowing physicians to perform exams and review information remotely (Wood; col. 11 line 54 to col. 12 line 11).

### ***Conclusion***



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10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches system and method for the rationalization of physician data (5,784,635), system and method for translating, collecting, and archiving patient records (5,903,889), and method and system for automated data storage and retrieval (6,308,171).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**12. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]


(703) 746-8374 [Informal/ Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).

CB

CB

January 10, 2005

  
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